

REMARKS35 U.S.C. § 102

Claims 1, 3, and 4 have been rejected under 35 U.S.C. § 102(e) as anticipated by Koeske et al (US 6,250,613). This rejection is respectfully traversed for the following reasons.

Claim 1 has been amended to recite the retainer "being integrally formed with the intermediate ribbed reinforcement structure." As the language is noted, in the Advisory Action as "suitable claim language", and as Koeske fails to teach or disclose showing a retainer being integrally formed with an intermediate ribbed structure as recited, it is respectfully requested that this rejection be withdrawn. Presumably, based on the Prior Office action, this language is held to distinguish the claim over Koeske et al.

35 U.S.C. § 103

Claims 5-6 stand been rejected under 35 U.S.C. § 103(a) as being unpatentable over Koeske et al. This rejection is respectfully traversed for the following reasons.

Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Koeske et al. in view of Geno et al. (US 4,946,144). This rejection is respectfully traversed for the following reasons.

Both of these rejections are based upon the 102 rejection of claim 1 as anticipated by Koeske et al. As argued above, Koeske et al fails to anticipate claim 1, as Koeske fails to disclose each and every element of claim 1. The rejections of the dependent claims fails to make up for this deficiency.

Claims 9-11 and 2 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Koeske et al.

In response to Applicant's prior argument, in the Advisory Action, it is stated that Koeske's disclosure that the spacer "is capable of use at either the retainer or piston side of the air spring fails to teach away from the structure being made unitary with the retainer." This statement paraphrases language from the Technical Field of the invention and the only teaching it provides is that the spacer can be mounted at either end of the air spring when mounting the air spring onto the vehicle. If anything, this reinforces Applicant's position that the spacer is desired to be a separate element so that it may be employed at either end of the air spring during mounting of the air spring; were the spacer formed as an integral element of

the air spring components as argued in the rejections, than the flexibility of being used at either end of the air spring is eliminated.

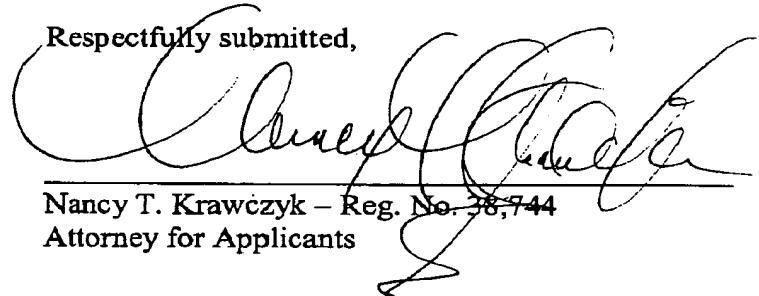
Koeske teaches that a problem with air springs is the "wide variety of shapes and sizes to fit the numerous suspension system configurations" and that manufacturers are "forced to provide each air spring configuration in a variety of heights and diameters so that each suspension application falls within the design envelope of at least one air spring assembly." (col 1, lines 46-53). The use of separate spacers, to be combined with an airspring thus expands the "design envelope of the air spring assemblies." Koeske teaches that the "spacers thus allow the manufacturer to decrease the total number of air spring configurations in its inventory and manufacturing line." (col 1, lines 57-60).

The identification of the item 10 by Koeske as a "spacer" (meaning something that creates intervals or something that arranges to form a space between other items), the consistent referring to the spacer as an element separate from the air spring, and the claims which recite "In combination, an air spring ... and a spacer adapted to mount the air spring.." (indicating that the air spring and the spacer are separate elements) clearly teaches those skilled in the art that the spacer is not an integral part of the air spring.

To form the spacer of Koeske unitary with the air spring as set forth in the prior rejections is contrary to the expressed goals of Koeske. Herein, the failure of Koeske to explicitly state that the spacer should not be formed with the air spring, though of all Koeske's teachings make it evident to those skilled in the art that the spacer is clearly intended to be a separate from the air spring, does not render the teachings of Koeske as a failure to teach away from forming the spacer integral with the air spring. Were one to form the spacer integral, then the primary goal of Koeske - "to decrease the total number of air spring configurations in its inventory and manufacturing line" - is destroyed as the manufacturers would once again be required to carry a larger number of air springs meeting numerous configuration.

When the prior art is specifically designed to meet a goal, to then state it would have been obvious to one in the art to do something in opposition to that goal, is not an issue of obviousness, but one of hindsight use of Applicant's own teachings. It is requested that the arguments previously presented by reconsidered and this rejection be withdrawn as the Examiner has failed to carry his burden of establishing a *prima facie* case of obviousness.

Respectfully submitted,


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